

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 9, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Regents of the University of California

v.

Joel B. Hodgell

Opposition No. 107,009
to application Serial No. 75/140,927
filed on July 29, 1996

J. Suzanne Seibert of Majestic, Parsons, Seibert & Hsue
for The Regents of the University of California.

Joel B. Hodgell, pro se.

Before Simms, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Joel B. Hodgell filed an application to register the
mark C@L in the format depicted below for "clothing,
namely, t-shirts, sweatshirts, long sleeve shirts, short
sleeve shirts, sweatpants, shorts and full length pants,
footwear and headwear."¹

¹ Serial No. 75/140,927, filed July 29, 1996, based on an
assertion of a bona fide intention to use the mark in commerce.

The Regents of the University of California filed an opposition to registration of the mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act and disparagement or false suggestion of a connection with opposer under Section 2(a) of the Trademark Act.

Opposer alleges that, since long prior to applicant's filing date, opposer has sold wearing apparel bearing the mark CAL; that applicant's mark so resembles opposer's mark as to be likely, when applied to applicant's goods, to cause confusion; that opposer has for many years been identified by the nickname CAL and is recognized by the public as such; that under Section 92000 of the Education Code of the State of California, no person may use any abbreviation of the name University of California to imply or suggest that any organization or product thereof is endorsed by the University of California, without consent; and that applicant's mark is so similar to opposer's mark CAL as to consist of matter which may disparage or falsely suggest a connection with the opposer.

Applicant, in his second amended answer, denied the salient allegations of the notice of opposition. Applicant's motion to further amend the pleadings will be

discussed *infra*.

The Record

The uncontested portion of the record consists of the file of the involved application; opposer's trial testimony deposition, with accompanying exhibits, of Maria K. Rubinshteyn, licensing manager for the University of California Berkeley; and copies of Article 9, Section 9 of the California Constitution, Section 92000 of the Education Code of the State of California² and applicant's responses to certain of opposer's discovery requests, all made of record by opposer's notice of reliance.

Applicant filed a notice of reliance which was the subject of a motion to strike filed by opposer. Decision of this motion was deferred until final hearing. Accordingly, we now consider the motion.

Applicant's notice of reliance offers materials designated from 1-24. Opposer has moved to strike the materials numbered 1, 2, 11, 12-14, 23 and 24. Applicant,

² Applicant's motion to strike this exhibit, which was filed seven months after the filing of opposer's notice of reliance, is denied as untimely. Furthermore, since the objection was based on relevancy, the proper procedure for applicant was simply to raise the issue of relevancy in his brief. See TBMP § 533. Applicant's further inclusion of numerous exhibits in

in response,³ has supplemented his notice with respect to materials numbered 1, 2, 11 and 12 and has agreed to the striking of the materials of 13, 14 and 23. Opposer has agreed that the deficiency in material 2 has been cured. Furthermore, we find that the certified copies of state registrations with which applicant has supplemented material 1 is adequate to permit the registrations to be introduced as evidence. Although opposer correctly argues that the registrations are incompetent to show use, applicant is also relying upon the registrations to show intended use. The soft copies of third-party registrations with which applicant has supplemented his previous trademark search reports (11 and 12) are also acceptable. See TBMP § 703.02(b).

Applicant's attempt to introduce his second amended answer as evidence in his behalf (material 24) is not well taken. While the answer may be accepted and made of record as a pleading in the case, the answer cannot be relied upon as evidence. All statements of fact made in the answer must have been established by competent evidence during the time

this motion and request that the Board take judicial notice thereof is also denied. Only those materials which were properly introduced by applicant's notice of reliance filed during his testimony period will be considered. The materials included by applicant in his motion go far beyond the generally known facts of which the Board may take judicial notice. See Fed. R. Evid. 201.

³ Applicant's motion to extend the time to respond to the motion to strike is granted.

for trial, such as by testimony deposition or the like. See TBMP § 706.01 and the cases cited therein.

In summary, opposer's motion to strike is granted to the extent that materials numbered 13, 14, 23 and 24 are stricken from the notice of reliance. Materials numbered 1, 2, 11 and 12, as supplemented, will be considered, as well as unchallenged materials numbered 3-10 and 15-22.

We next turn to opposer's rebuttal notice of reliance, and applicant's motion to strike the exhibits submitted thereby. Opposer has introduced materials in rebuttal to issues which opposer claims applicant has newly raised in his notice of reliance, namely, opposer's failure to defend its mark, the manner of usage of the @ symbol in the marketplace, and that opposer's mark is primarily geographically descriptive. Applicant has moved to strike these materials, on the grounds of relevancy and lack of probative value. Opposer has opposed the motion.

Applicant's motion to strike is denied. As we stated with respect to applicant's previous motion to strike, the appropriate procedure for applicant was simply to object to the relevancy of this material in his brief, and not to move to strike the material in its entirety. To the extent that applicant has objected to the material in his brief, the objections have been considered in determining the probative weight to be given to the evidence. Applicant's attempt

once again to introduce materials under the auspices of information of which the Board may take judicial notice is also denied. Opposer introduced its materials by means of a notice of reliance filed during its rebuttal testimony period. Applicant has no rebuttal period and is not entitled to submit further materials by means of requesting the Board to take judicial notice of the same.

Finally, we consider applicant's motion to amend his pleadings pursuant to Fed. R. Civ. P. 15(a) or (b) so as to specifically assert that opposer's mark CAL is "descriptive" and "geographically descriptive." Opposer has opposed the motion, arguing that the motion, which was filed after opposer's filed its main brief, is untimely.

Applicant's motion may well be untimely under Fed. R. Civ. P. 15(a). Nonetheless, under Fed. R. Civ. P. 15(b) the pleadings may be deemed amended at this point to conform to issues not raised by the pleadings, if tried by the express or implied consent of the parties. Here applicant did plead in his second amended answer that opposer's mark was "a generic term for matters relating to California and otherwise." Applicant also submitted material in his notice of reliance which was directed to the use of "Cal" as an abbreviation of the state of California and specifically stated that the material (Exhibits 8 and 9) was relevant to show that "Cal" is "primarily geographically descriptive."

Opposer raised no objection to this material in its motion to strike. Furthermore, opposer, in its rebuttal notice of reliance included material (Exhibits 11 and 12) for the specific purpose of rebutting the assertion of opposer's mark being primarily geographically descriptive as had been raised by applicant. Thus, upon considering the record as a whole, we find that the issue of opposer's mark being primarily geographically descriptive has been tried, by the implied, if not express, consent of the parties. Applicant's motion to amend is granted and the third amended answer has been made of record.

The Opposer

The Regents of the University of California are the governing board for the University of California, a nonprofit California corporation established to provide education to California residents. The University of California has nine separate campuses, with the main campus being at Berkeley. The curriculum includes, inter alia, computer science programs. The term "Cal" is considered by the University to be an abbreviation for the Berkeley campus name and both "Cal" and the "Cal" script logo [] to be trademarks of the campus. Under Section 92000 of the Education Code of the State of California, no person may,

without permission, use the name University of California, or any abbreviation thereof, to imply or suggest that any product or service of an organization is connected with, or endorsed by, the University of California.

Opposer has licensed its trademarks for a wide variety of merchandise, with one licensee since 1985 being Champion Products, for outerwear, T-shirts, sweatshirts and other clothing items bearing the mark CAL. Opposer has estimated sales of \$2.5 million of products sold under its various marks in the period 1991-1994 and \$3 to \$3.5 million in the period 1995-1997, with a "significant" percentage being attributed to goods bearing the CAL mark. Opposer advertises and sells its clothing products bearing the mark CAL in mail-order catalogs distributed to thousands of alumni and students (catalogs covering the years 1990-1996 have been made of record), in the Berkeley Magazine produced by the University and the California Monthly published by the California Alumni Association, and over the Internet. Both the Berkeley Magazine and the California Monthly are distributed throughout the United States, including the state of Washington (where applicant is located). Local retailers including a store on Pier 39 in San Francisco offer the CAL-marked goods for sale.

The games of the California Golden Bears, the Berkeley football team, are frequently televised, sometimes

nationally on FoxSports, and the team wears helmets bearing a gold CAL script logo. The team has from time to time participated in bowl games and emblematic merchandise has been sold in conjunction with the games. A video game featuring various football teams was produced by SEGA Genesis in 1995 in which the mark CAL was used to identify the University of California Berkeley team. In 1996 the CAL mark, with the opposer's permission, was displayed in basketball arena scenes in a film entitled "The Sixth Man."

Opposer has many campus outreach programs for disadvantaged or minority youth in the grades K-12 and its college of engineering in particular has a MESA (mathematics, engineering, science and achievement) program to assist students in being able to obtain post-secondary education in mathematics-based fields such as engineering and computer science.

The Opposition

Under the rule enunciated by our primary reviewing court in *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981), a party opposing registration of a mark on the ground of likelihood of confusion with its own unregistered term cannot prevail unless it shows that this term is distinctive of its goods,

either inherently or through the acquisition of secondary meaning. See *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990). Here applicant has challenged opposer's rights to allege likelihood of confusion, on the ground that opposer's claimed CAL mark is neither inherently distinctive nor has it acquired secondary meaning. While applicant argues that opposer's claimed CAL mark is both "geographically descriptive" and "descriptive," applicant is relying predominantly upon evidence of use of the term "Cal" as an abbreviation for the state of California. Accordingly, we find applicant's challenge best viewed as an assertion that opposer's CAL mark is primarily geographically descriptive, within the meaning of Section 2(e)(2) of the Trademark Act, when used in connection with its clothing items.

Opposer makes the initial argument that its CAL mark is inherently distinctive. Opposer contends that although the term CAL may have various meanings, when used on clothing the term CAL is being used in an arbitrary fashion. Opposer argues that the excerpts from the reference works which it has made of record (Opposer's Rebuttal Notice of Reliance Tabs 11 and 12) contain no suggestion that the state of California is noted or known for clothing.

Applicant has introduced evidence to show that the term "Cal" or "CAL" has several recognized meanings, including as

an abbreviation of the state of California. (Applicant's Notice of Reliance, Exhibits 8-10). Opposer is located in California and its goods originate from California. Thus, the question is not whether opposer is using CAL in an arbitrary fashion, but rather whether the manner in which opposer is using CAL is such that it would be perceived by the public as being *primarily* geographically descriptive of opposer's goods, i.e., that its primary significance is that the goods originate from the state of California. See *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988). If there is no question but that the term is primarily geographic in significance and the place named is neither obscure nor remote, which California is not, a goods/place association may be presumed. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

The fact that a term may have other meanings does not necessarily alter its primary significance as being geographically descriptive. See *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986). Although opposer points to the *Acronyms, Initialisms & Abbreviations Dictionary* (Applicant's Exhibit 10) as showing several other meanings for the term CAL, these do not detract from the potential primary significance of the term as being geographically descriptive when used by opposer with clothing. Applicant relies upon the third-party registrations he has made of

record (Applicant's Exhibit 11A) to show the incorporation by others, particularly other universities in California, of the term CAL in marks for clothing items and on opposer's own use of CALIFORNIA on other clothing items in its catalogs (Opposer's Exhibits 4-10) as evidence of the geographic significance of the term CAL.

Opposer, however, has shown by testimony and documentation, that the term CAL is considered to be an abbreviation for the University of California at Berkeley. This is not the same as an abbreviation for the state of California. The catalogs made of record by opposer all demonstrate use of the term CAL (along with CALIFORNIA) as a reference to the University of California, not the state of California. Under these circumstances, we find that applicant has failed to establish a prima facie case that the primary significance to the public of the term CAL, as used by opposer, would be as a geographically descriptive reference to the state of California. The fact that the abbreviation CAL is being used by opposer on college-type wearing apparel, such as sweatshirts, T-shirts and the like, only reinforces the significance of the term as a reference to the university.

Even if applicant had adequately established that the term CAL is primarily geographically descriptive, we find that opposer has fully demonstrated that the term had

acquired distinctiveness, or secondary meaning as an indication of source, prior to the filing by applicant of his intent-to-use application in July 1996. At the very least, opposer has shown use of the mark CAL since 1990, a period of over five years, which is sufficient in itself to serve as prima facie evidence that the mark has become distinctive. See Section 2(f) of the Trademark Act. In addition, opposer has made of record evidence of broad exposure to the public of the CAL mark in connection with opposer's sports teams, widespread distribution of catalogs and magazines advertising and offering for sale clothing items under its CAL mark and significant sale figures for these items for the period 1991-1997.

Accordingly, opposer has adequately established its superior rights, such that it may assert a claim of likelihood of confusion against applicant based on its use of the mark CAL as an indication of opposer as the source of the goods with which it uses this mark. See *Otto Roth & Co., Inc. v. Universal Foods Corp.*, *supra*.

Thus, we turn to the claim of likelihood of confusion and to those of the *du Pont* factors which are relevant under the present circumstances.⁴

⁴ In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the goods of the parties are concerned, opposer has established use of its mark CAL on various clothing items, in particular the items produced by its licensee Champion Products, which include outerwear, sweatshirts, T-shirts and the like, and the items shown in its catalogs which include, inter alia, jackets, shirts, and caps. These items are identical to those listed by applicant in the identification of goods in his application.

Furthermore, there being no limitation in the identification of goods in the application as to any particular channels of trade, it must be presumed that applicant's goods would travel in all the normal channels of trade and be sold to all the usual purchasers for goods of this nature. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Although applicant argues that his goods are intended to be sold by students from the Seattle public schools in their student-owned cooperative businesses by means of person-to-person sales or cooperative stores, there is no limitation in the identification of goods which reflects this intention. Even if applicant had introduced evidence with respect to the probable channels of trade, which he has not, this evidence would be irrelevant, without a limitation in the identification of goods in the application. Opposer has shown that its goods are sold by mail order, at retail

stores and over the Internet. Since there is no limitation on applicant's channels of trade and applicant's goods are identical, we must assume that applicant's clothing items would be offered through these same channels of trade and to the same purchasers as opposer's goods. In addition, considering the nature of these clothing items and the conditions under which they are normally marketed, these purchasers would most likely buy the goods as impulse purchases, rather than only after careful consideration of the items.

Thus, a most significant factor in our analysis is the similarity or dissimilarity of the marks being used on these clothing items. It is well recognized that in general the greater the similarity of the goods, the lesser the degree of similarity of the marks which is necessary to support a conclusion that there will be a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Opposer argues that its mark CAL and applicant's mark C@L are similar in appearance, the only difference being the substitution of the letter "A" with the symbol @. Opposer contends that this substitution would be likely to be viewed by the public as merely a variation of its mark CAL, perhaps to give a contemporary look to the mark. Opposer points to the evidence which it has made of record

of recent similar substitutions of the @ symbol for the letter "A", such as the naming of a modern version of "Faust" as "F@ust, Version 3.0" or presenting the well-known song title "Take the 'A' Train" as "Take the @ Train" in the title of an article about freight-hopping with the assistance of high-tech items.

Opposer also argues that the marks are similar in sound, in that persons would be likely to pronounce applicant's mark as either "CAL" or "at Cal." In addition, on the basis that purchasers normally retain general, rather than specific, impressions of marks, opposer contends that the commercial impression of applicant's mark would be the same, or very similar, to opposer's mark.

Applicant argues that his C@L mark is a fanciful invented mark, which is to be spelled out and not pronounced as a regular word. Applicant states that his mark is a phonetic equivalent for the name "Seattle", in other words "'C' 'at' 'L'." Applicant points to the evidence which he has made of record with respect to the presence of the @ or "at" sign as a separate symbol on QWERTY keyboards and its usage in every e-mail address (Exhibits 2-6) as evidence of the readily recognizable distinction between the @ symbol and the letter "A". Applicant argues that the evidence submitted by opposer fails to establish that purchasers

would be confused by or substitute the @ symbol for the letter "A" or vice versa. Applicant contends this distinction between the @ symbol and the letter "A" results in different appearances for the marks as a whole.

Applicant further argues that because his mark is a spelled-out term similar to an acronym, and when pronounced sounds like the name of the city Seattle, the marks are different in sound as well. On this same basis, he argues that the marks are different in meaning, opposer's mark being an abbreviation for California and applicant's mark being a phonetic equivalent for the city of Seattle.

While applicant has argued that his mark is clearly distinguishable from opposer's CAL mark, in view of the differences in appearance and pronunciation, applicant has failed to make any evidence of record with respect to the manner in which his mark might be perceived by the purchasing public. Although applicant may intend for his mark to be pronounced as "'C' 'at' 'L'," it is well recognized that there is no correct pronunciation for a mark and thus purchasers may give the mark other pronunciations, including "CAL." See *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). Furthermore, while applicant alleges in his answer that the mark will be used together with other indicia which will make the connection between his mark and the city of Seattle clear, the mark

applicant is seeking to register is devoid of any such indicia. Without any reference to Seattle in the mark and without any testimony or other evidence as to potential purchaser perception of the mark, we are left with serious doubts as to whether any connection will be made between applicant's mark and the city of Seattle.

On the other hand, we find it highly likely that at least a significant portion of the purchasing public will view applicant's mark C@L as CAL. The evidence of record shows that opposer uses its mark not only in the typed form CAL but frequently in the script logo form depicted *supra*. In fact this is the format which is used on the helmets of the University of California football team and which is seen by sports viewers nationwide. The catalogs of record show use of the script logo form on clothing items. Thus the letter "A" is frequently used by opposer in its CAL mark in lower case, which is highly similar in appearance to the @ symbol in applicant's C@L mark. Since both parties are using their marks on clothing items such as sweatshirts and T-shirts which could be offered for sale side-by-side in a retail outlet, the possibility that purchasers would simply mistake one mark for the other is great.

Furthermore, even if purchasers actually note the presence of the @ symbol rather than the letter "A" in applicant's mark, they may very well consider the mark

simply to be another variation of opposer's CAL mark. Opposer has established that computer science programs are among the curriculum offered by the university. Opposer has campus outreach programs in mathematics-related fields including computer science. Applicant's mark might reasonably be viewed as a variation sponsored by the computer science school in keeping with the common use of the @ symbol in the computer world and especially on the Internet.

Thus, on the record before us, we are led to the conclusion that the respective marks would create similar overall commercial impressions, particularly when used on identical clothing items such as sweatshirts or T-shirts.

Another factor to be considered is the degree of fame of the prior mark, namely, opposer's CAL mark. We have earlier found that opposer has presented evidence sufficient to establish that the term CAL has acquired distinctiveness as an indication of opposer as a source. We find this evidence sufficient to establish that opposer's mark CAL is well-known, not only in connection with the university itself and its sports teams, but also in connection with the college-related clothing items upon which opposer bases its present opposition. This renown clearly weighs in opposer's favor, in that confusion is more likely to occur when a mark is well-known because of the propensity of purchasers to

associate a little-known mark with one which is more familiar to them. See *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895 (TTAB 1989).

The only other factor which we consider relevant, in view of the fact that applicant is not yet using his mark, is the extent of third-party use of similar marks for similar goods. Applicant has introduced third-party registrations for other marks containing the term CAL, but for the purpose of showing the geographic significance of the term. Applicant has introduced no evidence which would establish use, as opposed to registration, of these or other third-party marks containing the term.

While applicant has raised the issue of opposer's failure to successfully exclude others from using CAL-based marks, the evidence is sufficient to show that opposer has taken steps to protect its mark. Opposer filed an opposition against registration of the mark CAL KIDS for children's wearing apparel. Although the applicant subsequently abandoned the application, rather than proceed with the opposition, opposer clearly prevailed. (Opposer's Rebuttal Notice of Reliance, Tab 6). In the case of the mark CAL 150, while opposer did not follow up on its extension of time to oppose, opposer has stated, although not proven, that an agreement was reached with respect to

use of that mark.⁵ In any event, there is minimal evidence of third-party use of similar marks for similar goods.

Accordingly, upon weighing all of the relevant *du Pont* factors, and particularly on the basis of the similarity of the marks and the identity of the goods upon which the marks are being, or will be, used, we find the balance to fall in opposer's favor. If any doubt remains, this also must be resolved in favor of opposer as the senior user of its well-known mark and against applicant as the newcomer. See *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); *San Fernando Electric Mfg. Co v. JFD Electronics Components Corp.*, 565 F2d 683 , 196 USPQ 1 (CCPA 1977). We find that there is a likelihood of confusion if applicant were to use his mark C@L in connection with the recited clothing items, in view of opposer's use of the mark CAL on similar items.

Although we have already held in opposer's favor on its claim of likelihood of confusion, for the sake of completeness, we will also consider its claims of disparagement or false suggestion of a connection with

⁵ Inasmuch as opposer's rebuttal testimony period had closed by the time of this agreement, the agreement which was later attached to opposer's opposition to applicant's motion to strike the rebuttal notice of reliance is not part of the evidence before us. Contrary to opposer's arguments, we find no basis in *Viking Boat Company, Inc. v. Viking Camper Supply, Inc.*, 191 USPQ 297 (TTAB 1976) for our consideration of evidence introduced after the close of the testimony periods.

opposer under Section 2(a). We note that opposer has made only minimal reference to these claims in its brief, and has failed to show how the evidence of record might support a claim of disparagement.⁶ Insofar as a claim of false suggestion of a connection with opposer is concerned, the first requirement which opposer must satisfy is that applicant's mark is the same as or a close approximation of a previously used name or identity of opposer. See *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993); *Buffett v. Chi-Chi's Inc.*, 226 USPQ 428 (TTAB 1985). Although we have found that opposer's mark CAL and applicant's mark C@L are similar, we have not found, nor do we find, applicant's mark to be the same as, or a close approximation of, a name or identity of opposer, including its recognized abbreviation CAL. On this basis alone, opposer's claim must fall. Opposer has failed to prove either disparagement or false suggestion of a connection with opposer under Section 2(a).

⁶ See *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705 (TTAB 1999) for a discussion of the elements required to establish a claim of disparagement.

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Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d).

R. L. Simms

H. R. Wendel

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board

Opposition No. 107,009